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(For Patent Owner)

In re Orbach
Reexamination Proceeding
Control No. 90/006,197
Filed: January 17, 2002
For: U.S. Patent No. 4,949,257

In re reissue application of
Orbach
Application No. 10/668,094 ✓
Filed: September 22, 2003
For: U.S. Patent No. 4,949,257

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REEXAM UNIT

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: DECISION
: MERGING
: REEXAMINATION
: AND REISSUE
: PROCEEDINGS
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The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 4,949,257 issued to Orbach, on August 14, 1990.
2. Reexamination of the '257 patent was requested by the patent owner on January 17, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,197.
3. Reexamination was ordered in the '6197 proceeding on March 11, 2002.
4. On May 16, 2002, a patent owner's statement was filed in which new claims 19-54 were added.
5. A non-final rejection was mailed in the '6197 proceeding on October 30, 2002.
6. On January 2, 2003, a response was filed in the '6197 proceeding.
7. A final rejection was mailed in the '6197 proceeding on March 24, 2003.
8. On June 2, 2003, a proposed amendment of claim 1 was filed in the '6197 proceeding in response to the final rejection.
9. An advisory action was mailed on August 18, 2003, in the '6197 proceeding, advising the patent owner that the proposed amendment in response to the final rejection was not entered.
10. Patent owner filed a reissue application based on the '257 patent, on September 22, 2003, which was assigned Application No. 10/668,094. The specification was amended in Col. 2; claims 1, 2, 9, 14 and 16-18 were amended; and new claims 19-75 were added.
11. On September 23, 2003, a Notice of Appeal was filed in the '6197 proceeding

12. On September 29, 2003, a proposed amendment of claims 1, 2, 9, 14-20, 27, 32-38, 45 and 50-54 was filed in the '6197 proceeding in response to the final rejection.
13. A Notice of Incomplete Application was mailed in the '094 reissue application on December 1, 2003.
14. An advisory action was mailed in the '6197 proceeding on December 18, 2003, advising the patent owner that the second proposed amendment in response to the final rejection was not entered.
15. On April 27, 2004, a petition to revive the '6197 proceeding was filed, and was accompanied by an Appeal Brief.
16. A response to the Notice of Incomplete Application was filed on July 6, 2004, and the reissue application was found to be complete.
17. Notice of the filing of the '094 reissue application was published in the *Official Gazette* on October 5, 2004.
18. A decision granting the petition to revive was mailed in the '6197 proceeding on February 23, 2005.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6197 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '6197 reexamination file shows that in the amendment of May 16, 2002, new claims 19-54 were added.

A review of the reissue (Application No. 10/668,094) prosecution history shows that the reissue application was published in the *Official Gazette* on October 5, 2004. In the reissue application, patent owner has amended the specification at Col. 2; amended claims 1, 2, 9, 14 and 16-18; and added claims 19-75. Therefore, the specification and claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/668,094, and Control Number 90/006,197. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (i.e., the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173**, therefore all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g) and all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (i), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, e.g., all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to

35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e.,* the reissue application and the reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (i.e., the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under

reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.
2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 3600. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.
4. The examiner should withdraw the finality of the previous Office action in the reexamination proceeding, and issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of the following events have occurred:
 - (a) the submission of the housekeeping amendment to place the same amendments in both cases; or
 - (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.
5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the

Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II and III of this decision.
7. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7722.



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Office of Patent Legal Administration

March 23, 2005